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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/814,302

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Darrel D. Cherry

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02/03/2006

HEWLETT-PACKARD COMPANY

Intellectual Property Administration

P.O. Box 272400

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EXAMINER

BILGRAMI, ASGHAR H

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,302

Applicant(s)

CHERRY ET AL.

Examiner

Asghar Bilgrami

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiser et al (U.S. 5,982,507) and Drucker et al (U.S. 6,292,796)

3. As per claims 1, 9 & 12 Weiser disclosed a system for distributing information comprising: a first client computer having first software with a print functionality; a second client computer; a network connecting said first and second client computers (col.4, lines 26-44 & col.5, lines 1-6). However Weiser did not explicitly disclose means for effecting communication of a document from said first client to said second client as email via said print functionality thereof.

In the same filed of endeavor Drucker disclosed means for effecting communication of a document from said first client to said second client as email via said print functionality thereof (col.10, lines 21-32).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to have incorporated the means of effecting communication of a document from one client to another as e-mail via a print functionality as disclosed by Drucker to the system of distributing

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information as disclosed by Weiser in order to provide the user with a more versatile, flexible and user friendly network experience.

4. As per claim 2 Weiser-Drucker disclosed the invention of Claim 1 wherein said first software is application software (Weiser col.4, lines 60-67).

5. As per claim 3 Weiser-Drucker disclosed the invention of Claim 1 further including a server connected to said network (Weiser col.4, lines 26-44).

6. As per claim 4 Weiser-Drucker disclosed the invention of Claim 3 wherein said means for effecting communication includes means for communicating said document through said server (Weiser col.1, lines 55-67, col.2, lines 1-5 & col.5, lines 1-6).

7. As per claim 5 Weiser-Drucker disclosed the invention of Claim 4 wherein said means effecting communication includes a first agent running on said client (Weiser col.1, lines 45-51 & col.5, lines 1-6).

8. As per claim 6 Weiser-Drucker disclosed the invention of Claim 5 wherein means for communicating includes a second agent running on said server (Weiser col.8, lines 23-27).

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9. As per claim 7 Weiser-Drucker disclosed the invention of Claim 1 further including email software running on said second client for receiving said document (Weiser col.1, lines 23-30 & col.8, lines 10-19)

10. As per claim 8 Weiser-Drucker disclosed the invention of Claim 7 wherein said email software includes means for receiving a message associated with said document from said first client (Weiser col.1, lines 35-42 & col.3, lines 32-39).

11. As per claim 10 Weiser-Drucker disclosed the invention of Claim 9 further including email software running on said second client for receiving said document (Weiser col.2, lines 25-30, col.5 & lines 50-57).

12. As per claim 11 Weiser-Drucker disclosed the invention of Claim 10 wherein said email software includes means for receiving a message associated with said document from said first client (Weiser col.2, lines 25-30, col.3, lines 32-39).

Response to Arguments

13. Applicant's arguments filed 9 January 2006 have been fully considered but they are not persuasive.

14. Applicant argued that Weiser nor Drucker, individually and combined, fail to teach or suggest "means for effecting communication of a document from said first client to said second

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client as e-mail via said print functionality thereof". With respect to the passage from Drucker, col.10, lines 21-32 cited by the examiner the applicant stated that "the cited passage does not suggest means for effecting communication of a document from said first client to said second client as e-mail via the print functionality of a client computer's software as recited in claim 1. The applicant pointed out to figure 6c of Drucker and pointed out "There is no suggestion that the selection of print button (634A) would cause the full text to be communicated from one device to another as e-mail via a software's print functionality as recited by claim 1. There is no suggestion that the selection of e-mail button (634B) causes the execution of a software print functionality".

15. As to applicants arguments the examiner would like to get applicants focus on the independent claim language, the term "means for effecting communication of a document" stated in the claim language is interpreted by the examiner as, a simple e-mail or print command that is invoked by the client on a certain text, file or document. In this situation a communication means of sending a document was affected by a client's action.

16. Additionally as to the applicant's argument stating "There is no suggestion that the selection of print button (634A) would cause the full text to be communicated from one device to another as e-mail via a software's print functionality as recited by claim 1. There is no suggestion that the selection of e-mail button (634B) causes the execution of a software print functionality".

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17. As to applicant's argument the examiner would like to point out that claim 1 language **does not** talk about selection of print button to cause the full text to be communicated to another device as e-mail. Even if the claim language did talk about such limitation it would have obvious to change e-mail button (634A) to print button (634B) to achieve e-mailing of a document to another client via a print button. The examiner again advises that for proper examination of the claimed invention the applicant should clarify the independent claims language by adding to the claim language what the invention is actually doing instead of using cryptic term to define the invention.

18. **For clarification purposes only** the examiner considered the explanation defined by the applicant in this application's (09/814302) specification (page, 5, lines 3-23) regarding the "means for effecting communication of a document from said first client to said second client as e-mail via said print functionality thereof" recited in claim 1. **Although none of this information is disclosed in the claims** of this application the examiner has tried to map the limitations defined in the cited specification to show the applicant how he is interpreting the invention from the specification. The examiner has used a prior art Inohara et al (U.S. 6,385,606 B2) that is not relied upon but is considered pertinent to applicants disclosure to address the limitation described in the specification.

19. {09/814302, Specification; Page5, lines 6-8} states, "a user desiring to **e-mail** the document to one or more recipients, first selects "print" from the native application".

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20. Using as print tab instead of an e-mail tab to e-mail a document in an application is nothing novel, it can be achieved by making a mere cosmetic change in the software application.

21. {09/814302, Specification; page.5, lines 9-23} The port monitor launches an agent that transfers the file and retrieves a user interface from the server that presents the user with a list of document service selections. One of these selections is the function of electronic distribution. When the user chooses this selection, the user is provided with a user interface by the server 30 to input destination email addresses. After user provides destination information and selects “send”, the client agent transmits the destination information to the server agent then attaches the printed file, which can be in different formats from the original format, postscript format (.PS), or portable document format (.PDF) depending on the user destination information, and emails it to the email destination specified by the user in the destination field (Inohara, col.5, lines 46-67, col.6, lines 1-37 & col.21, lines 47-49).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asghar Bilgrami whose telephone number is 571-272-3907. The examiner can normally be reached on M-F, 8:00-5:00PM.

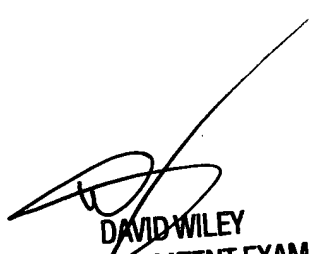
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


AB

Asghar Bilgrami
Examiner
Art Unit 2143


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